

REMARKS

Entry of this Amendment, reconsideration of the restriction requirement and allowance of the above-captioned patent application are respectfully requested. This application relates to aminoalkylphosphonates and related compounds as edg receptor agonists.

Claims 1 to 17, 19, 28 and 29 are currently pending in the application. This Amendment cancels Claims 5 and 19 and amends Claims 1, 8 and 9. Upon entry of this Amendment, claims in the application will be Claims 1 to 4, 6 to 17, 28 and 29.

The Examiner has required restriction of Claims 1 to 17, 19, 28 and 29 and an election of one of Groups I to XVIII as described in the Office communication dated November 28, 2006. Applicants hereby elect Group I and the species of Example 3 at page 18. This election is made with traverse.

Applicants respectfully request reconsideration of the restriction requirement with respect to 1 to 4, 6 to 17, 28 and 29 as amended and submit that these claims satisfy the unity of invention requirement because the groups are properly linked to form a single general inventive concept. As outlined in M.P.E.P. § 1893.03(d), a group of inventions is considered linked to form a single general inventive concept when there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression "special technical feature" is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. In the instant claims, the special technical feature is the novel and non-obvious core structure embodied in Formula I. All compounds share this significant common chemical structure. The claimed compounds also possess the same utility as Edg receptor agonists and for treating diseases or conditions mediated by that receptor. As such, unity of invention is present.

Furthermore, M.P.E.P. § 1983.03(d) states that "the Examiner must ... (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." In the instant application, the Examiner has not explained why the significant structural core embodied in Formula I is not a special technical feature that fails to make a contribution over the prior art. The Examiner's arguments with respect to the vastness of the claimed subject matter and burden

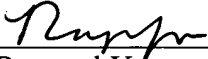
Serial No.: 10/505,257
Case No.: 21044P
Page 15

of examination at page 12 of the Official communication are not the proper standard for a unity of invention determination.

Applicants submit that the separation of the members of A into two separate groups is improper as these are all acidic groups properly combinable into one group. Likewise, Applicants submit that the members of B-C in Claim 1 as amended are also properly combinable into one group as B-C forms part of the significant structural element embodied in Formula I. Applicants respectfully request that the method of treatment claims be considered for rejoinder upon a finding by the Examiner of an allowable product claim.

Applicants respectfully request entry of this Amendment and reconsideration and withdrawal of the requirement for restriction. Applicants submit that the application is in condition for allowance and passage thereto is earnestly requested. Any additional fees required in connection with this Amendment and Response may be taken from Merck Deposit Account No. 13-2755. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the case.

Respectfully submitted,

By 
Raynard Yuro
Reg. No. 45,570
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-0182

Date: December 12, 2006